



GAU 2876

PATENT

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Thomas D. Petite ✓

Serial No.: 08/910,980 ✓

Filed: August 7, 1997 ✓

For: Transmitter for Automatically
Communicating Information to a
Communication Device

Group Art Unit: 2876

Examiner: D. Rodriguez

Docket No. 8160/-1012

REPLY TO EXAMINER'S ANSWER

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

This is in reply to the Examiner's Answer in the above-identified appeal.

Response to Paragraph 2

Appellant acknowledges the Examiner's correction to Appellant's statement, whereby the Examiner corrected the citation to U.S. Patent 5,926,531, instead of U.S. Patent 5,926,530.

Response to Paragraph 7

In paragraph No. 7, the Examiner disagreed with Appellant's statement that certain claims do not stand or fall together. Specifically, the Examiner's position is that

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there is insufficient distinction between the elements "receiver" and "receiving means".

Appellant respectfully traverses this position taken by the Examiner.

This, in fact, emphasizes one area of disagreement between the Appellant and the Examiner. Throughout the prosecution of this application, the Appellant has argued that the Examiner's interpretation of various claim elements has been improper. Specifically, the Appellant has argued that the Examiner has failed to properly construe claim elements under 35 U.S.C. § 112, paragraph six. The Examiner's position in this appeal emphasizes this point of disagreement.

The claim term "receiver" (*e.g.*, claim 12) falls outside of 35 U.S.C. § 112, paragraph six, while the interpretation of the term "receiving means" (*e.g.*, claim 1) is governed directly by 35 U.S.C. § 112, paragraph six. The purpose and effect of 35 U.S.C. § 112, paragraph six, is to accord such differing claim terms a differing interpretation. The interpretation of elements construed under 35 U.S.C. § 112, paragraph six, is limited to the structure (and structural equivalents) of the disclosure contained within the specification, while elements not construed under 35 U.S.C. § 112, paragraph six, are not so limited. The Examiner's position effectively eviscerates the entire purpose and effect of 35 U.S.C. § 112, paragraph six.

The effect of the substance of this distinction will be discussed in Appellant's response to Paragraph 11, below.

Response to Paragraph 11

For reasons more fully set out in Appellant's opening Appeal Brief, Appellant generally disagrees with the Examiner's position. However, Appellant will not reargue

these same points herein. However, Appellant does offer the following additional comments, in light of the Examiner's Answer.

Comments on Claim Group I

First, the Examiner has misconstrued the term "receiving means." Title 35 U.S.C. § 112, paragraph six, requires that means plus function claim elements be construed in light of the structural embodiments disclosed in the specification, and the equivalents thereof. The Examiner has specifically construed "the 'receiving means' as an RF transceiver." (Examiner's Answer, p. 5, line 1). Appellant respectfully traverses this construction of the "receiving means" element. The specification of the present application teaches that the receiver may be an ultrasonic or infrared receiver. (see p. 8, lines 16-20). From this and other teachings of the specification, it is clear that the Examiner's construction of the "receiving means" element is unduly narrow, and incorrect as a matter of law. Based upon the above-cited and other teachings of the Appellant's specification, the "receiving means" element should more appropriately be construed as any receiver capable and configured to receive a "wireless" communication containing user identification data, not just a wireless communication in the RF frequency band.

Second, in rejecting claim 1, the Examiner has wholly failed to address the "low-power transmitter adapted to transmit the user identification data to the receiving means" element, which Appellant specifically emphasized in its Appeal Brief. The specification of the present application specifically teaches that

the transmitter 20 is an extremely low power transmitter, so that a user will have to be in close proximity, (*e.g.*, several feet) to the receiver 18 of an AFTM 10 in order to use the transmitter. This would help alleviate problems which may otherwise occur if a user approaching an AFTM 10 is circumvented by a second, more distantly located user who depresses his transmit button. This extremely low-power operation helps to prevent the unlawful interception of the electromagnetic signals.

(Specification, p. 11, lines 3-8). It is clear from the teachings of the Gutman patent that the information communicated by that system is communicated much longer distances.

In this regard, Gutman discloses a telephone interface, whereby the information is communicated via the PSTN. Gutman also discloses a paging transceiver, which can communicate information to a remote financial institution via wireless communication. Nevertheless, the distance of communication is much larger than the relatively short distance traversed by Appellant's "low-power transmitter." This is not a trivial claim limitation, which can simply be ignored, as the Examiner has thus-far done.

As is clear from even a cursory review of the Appellant's disclosure, the present invention is significantly different, in both purpose and effect, than the system taught in Gutman. Certain subtle features, such as the claimed low-power transmitter, help to technically distinguish the invention over Gutman. To date, the Examiner has failed to give the proper force and effect to these claim terms, and has instead simply ignored them. Therefore, the rejections should be overturned as a matter of law.

Comments on Claim Group II

Claim 9 of Claim Group II claims a step of "transmitting a low-power electromagnetic signal..." Although the Examiner did acknowledge this element, the Examiner gave absolutely no force and effect to the "low-power" limitation. In response,

the Examiner said only that "Gutman fails to state the transmission of user identification information in such precise words, however, such limitation would necessarily be present in view of the data being transmitted." Thus, the Examiner acknowledges a specific failing of Gutman to disclose the "user identification data" claimed in the present invention, but somehow concludes that such a limitation would "necessarily be present."

First, Appellant submits that such an approach and conclusion is not within the discretion of the Examiner, and is improper as a matter of law. For this reason alone, the rejection should be overturned.

Second, and more significantly, the Examiner has again wholly failed to acknowledge or respond to the "low-power" limitation of the transmitting step. Appellant specifically emphasized this element in its Appeal Brief to draw attention to its significance. The Examiner, however, has simply ignored this limitation of Applicant's invention. No such feature is taught or suggested in Gutman. Therefore, the Examiner's rejection should be overturned as a matter of law.

In addition, claim 9 also defines the step of "transmitting the extracted information over the telephone line for authorization." Gutman fails to disclose the claimed method steps because Gutman does not contemplate the communication device of the present invention. Gutman not only fails to disclose the claimed functionality, but Gutman further fails to disclose structure that is claimed, and that imparts the claimed functionality. At least the foregoing method steps and limitations are missing from Gutman.

Comments on Claim Group III

The system of the Gutman patent essentially teaches an electronic wallet that communicates with a remote financial institution. The communication is effectively a two endpoint communication, with the financial institution on one end and the electronic wallet on the other. In contrast, the Appellant's invention includes three devices along the communication path: the remote access unit (containing the low-power transmitter), an intermediary "communication device" (e.g., telephone, set-top box, *etc.*), and ultimately the financial institution. Claim 12 specifically claims the relationship between the "remote access unit" and the "communication device." The Examiner, however, summarily dismissed Appellant's argument.

The Examiner's position equates the financial institution of Gutman to the claimed "communication device" and the electronic wallet of Gutman to the claimed "remote access unit". Such a strained interpretation, however, renders meaningless the entire purpose of the "communication device," which is to relay communication from the remote access unit on to a centralized database.

For at least this reason, the Examiner's rejection should be overturned.

Comments on Claim Group IV

The Examiner's rejection of Claim Group IV should be overturned for at least the same reason as the Examiner's rejection of Claim Group III. In addition, claim 14 of Claim Group IV specifically claims that the remote access unit has "a low-power transmitter." The Examiner's answer again failed to accord any weight or credibility to this claim limitation.

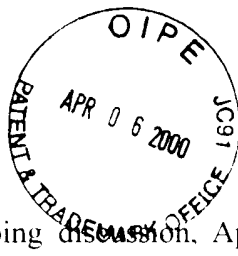
For at least this reason, the Examiner's rejection should be overturned.

Comments on Claim Group VI

The Examiner's answer has advanced a confused rejection to claim 16. On page 8 of the Examiner's Answer, the Examiner references the rejection of Claim Group I. However, in Paragraph 10 of the Examiner's Answer (page 4), the Examiner states that claim 16 is rejected only under 35 U.S.C. § 112, second paragraph. No substantive ground of rejection to this claim is set forth in paragraph 10 of the Examiner's Answer. Therefore, Appellant does not understand the purpose of the substantive comments on pages 8 and 9.

Claim 16 was rejected under 35 U.S.C. § 112, second paragraph, for failing to provide proper antecedent basis to the claim limitation of "the track one and track two data." Appellant's amendment after Final, which was not entered, sought to correct this error, by deleting the term "the," which preceded the phrase "track one and track two data." Certainly, Appellant would be agreeable to such an amendment to place this claim in condition for allowance.

CONCLUSION



Based upon the foregoing discussion, Applicant respectfully requests that the Examiner's final rejection of claims 1-16 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims 1-16.

No fee is believed to be due in connection with this reply. If, however, any fee that may be due or required is authorized to be charged to Deposit Account No. 20-0778.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Daniel R. McClure".

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A handwritten signature in cursive script, appearing to read "Daniel R. McClure".

Signature